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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,925	08/14/2001	Peter D Davis	3764-100	2929
9629	7590	01/07/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			LUKTON, DAVID	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/869,925

**Applicant(s)**

DAVIS ET AL.

**Examiner**

David Lukton

**Art Unit**

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4-7, 13 and 15 is/are rejected.
- 7) ☒ Claim(s) 8-12 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Pursuant to the directives of the preliminary amendment filed 10/15/04, claims 13 and 15 have been amended. Claims 2 and 4-15 are pending.



Claims 13 and 15 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

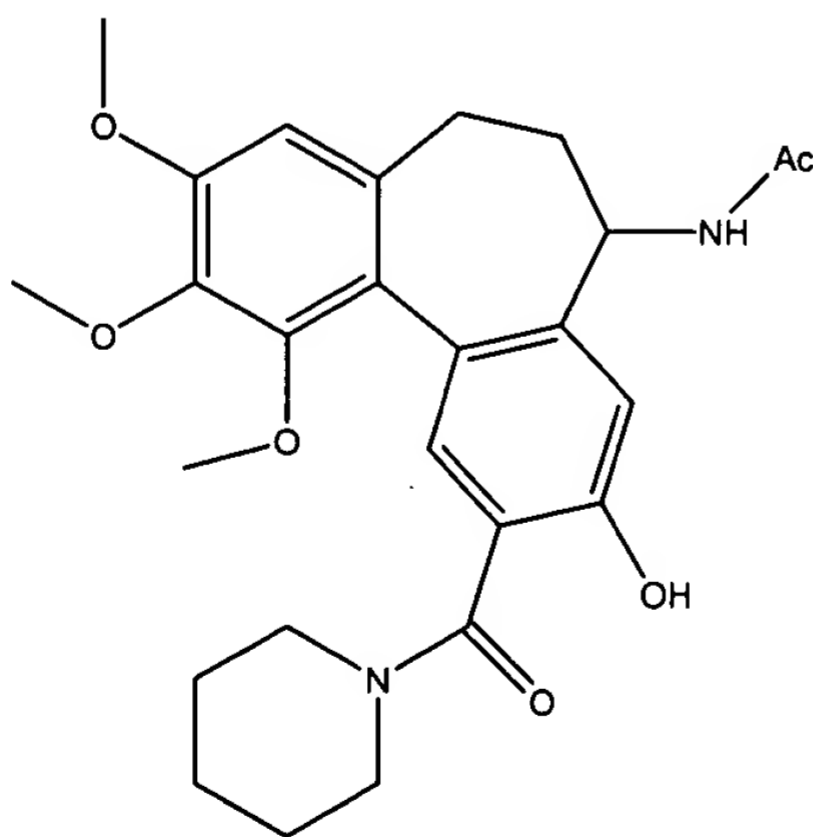
- Claim 13 recites that a compound of formula IIa can be prepared by a Sandmeyer reaction conducted on a compound of formula III or IV. Does this mean that any compound according to formula III or IV will produce a chlorine atom at the appropriate position under the conditions of the Sandmeyer reaction, or are there only certain compounds which will produce the target chloroaryl compound?
- Claim 15 is indefinite as to the nature of the “vascular damaging effect”. In response, applicants have pointed to page 1 of the specification, where the phrase at issue is recited. At line 24+ (page 1), it is stated that the claimed compounds specifically target newly formed vasculature without affecting the established vascular epithelium, and that this selective damage is of value in the treatment of angiogenesis mediated disorders. Certainly, the skilled artisan would have no difficulty understanding the subject matter discussed on page 1 of the application. But the question remains as to whether the skilled artisan would come to believe that the meaning of the phrase “vascular damaging effect” is limited only to “newly formed vasculature”, and only in animals in which excessive angiogenesis has occurred. It is appropriate for an examiner to give terms in claims their broadest possible interpretation. Accordingly, it is unclear whether the claim encompasses damage to normal, healthy tissue. Perhaps applicants could claim *a method of inhibiting neovascularization by damaging vascular epithelium.*



A person shall be entitled to a patent unless -

Claims 2 and 4-7 are rejected under 35 U.S.C. §102(b) as being anticipated by Dilger (*J. Prakt. Chem* **340**, 468, 1998).

Dilger discloses compound cmpd 22 (page 469), which has the following structure:



This is encompassed by claim 2 when the substituent variables are as follows:

$R^1$  = methyl

$R^2$  = methyl

$R^3$  = methyl

X is  $>CH-NH-Ac$

$R^5$  is hydroxy;

$R^6$  is  $-CO-piperidine$

Thus, the claims are anticipated.



- Reference "IR" (Dokl Acad Nauk USSR, 1991) was stricken from the IDS because a translation was not provided.
- Reference "KR" (second reference with this designation) was stricken from the IDS because a translation was not provided.
- Reference "LR" was stricken from the IDS because a translation was not provided.

Reference "KR" (Fernholz) was stricken from the IDS because a translation was not provided.

Reference "LR" was stricken from the IDS because a translation was not provided.

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It is suggested that applicants submit an IDS which begins with the following:

*English Abstract of ... [etc.]*

This will make it clear that the full document was not considered.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800